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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/996,338
Filing Date: November 27, 2001
Appellant(s): GRAINGER, JEFFRY J.

MAILED

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GROUP 3600

William J. Daley
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 2, 2006 appealing from the Office

action mailed January 14, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief

identifying the real party in interest as FTF, Inc. (should be FTF Technologies, Inc.).

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings

known to the examiner which may be related to, directly affect or be directly affected by

or have a bearing on the Board's decision in the pending appeal:

Application number 09/997,311.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,434,580	Takano et. al.	8-2002
6,584,466	Serbinis et. al.	6-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1.   Claims 4-9, 11-13 and 19-43 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Takano et al (6,434,580) (hereinafter referred to as Takano) in view

of Serbinis et al (US 6,584, 466) (hereinafter referred to as Serbinis).

Referring to Claim 19:

Takano discloses method of managing electronic documents related to patent

applications, the method comprising:

allowing users to create a plurality of invention disclosures (invention reports,

draft data for a specification) for each respective technology developer (inventor) for a

plurality of different and unrelated technology developers (inventors, (100, 200)) (col. 2,

lines 1-10, col. 7, lines 54-63, Figs. 1-18);

receiving the invention disclosures from the users at a server system (300) over

a network ((col. 5, lines 49-51 – these computers operate under programmed control

and are connected to one another via a communication network such as the Internet)

and storing the invention disclosures in one of a collection of electronic documents and

data in a computer-readable memory coupled to the server system (310), wherein each

document is associated with one of a patent application and assigned to at least one

group (plurality of entities for registering plural pieces of invention report information –

col. 7, line 54 thru col. 8, line 5;

storing additional electronic documents associated with some of the invention

disclosures in the database (col. 13, line 45 thru col. 14, line 64);

maintaining and enforcing rights to electronic documents such that at least some

users can access selected ones of the documents and such that users cannot access

documents associated with unrelated technology developers (col. 8, lines 7-24 (displays

only those [pieces or invention report information] satisfying specific conditions [e.g.

only those pertaining to inventors belonging to a specific department);

maintaining and enforcing rights to electronic documents such that at least some

users have rights to view selected invention disclosures stored in the database and

create and modify patent applications from the invention disclosures (col. 8, line 52 thru

col. 9, line 8 – patent-application-filing persons are enabled to revise the draft data);

receiving created patent applications at the server system and storing the

applications in the database (col. 8, lines 7-11 (upon registration of the draft data for the

specification for patent application and the pertinent piece of invention report

information into the server computer), col. 16, lines 26-34 upon completion of final

revision of the draft data by patent-application-filing persons, the draft uploading means

(203) or the client computer (300) transmits the draft data and the piece of invention

report information on the draft data to the server computer (300));

electronically receiving a request from a user to file a patent application,

determining if the system has rights to file the patent application and causing the

application to be file (col. 9, lines 1-8, col. 16, line 15 thru col. 18, line 18, Fig. 18 (1000).

Takano discloses a *plurality* of computers connected over a communication

network, such as the Internet (col. 1, lines 8-18) wherein the client computer is used by

a person of a patent attorney office (col. 6, lines 5-15). Takano does not disclose

databases for client systems associated with a *plurality* of patent firms, or wherein each

user is assigned one or more roles that are associated with a set of permissions used to

determine if a user can perform a particular operation on a particular document in the

database; or wherein when a user generates a request to perform a particular

operation, determining whether a user may access the document and data, the level of

access, determining the user's one or more roles associated with the set of

permissions, and determining if the user can perform the operation requested on the

document.

However, Serbinis teaches a method for Internet based document management

wherein an electronic document may be stored on an Internet accessible server and

accessed using a web browser, down loaded for review or manipulation and returned to

the server for access by further users (collaborative file sharing service, col. 2, lines 15-

20) and Serbinis also teaches an Internet-based document management system and

method that permit users to access a plurality of services supported by a common

Internet-based database (col. 2, lines 52-57) The fact that one set of the plurality of

users are patent law firms does not effect the document management method that

permits users to collaboratively store, retrieve, modify and then return an electronic

document to an Internet-based storage site. Therefore, it would have been obvious to

one of ordinary skill in the art to have the plurality of computers be computers at a

plurality of law firm since this does not alter the steps of the method claimed.

Serbinis also discloses wherein each user is assigned one or more roles that are

associated with a set of permissions used to determine if a user can perform a particular

operation on a particular document in the database (col. 2, lines 41-43 – provide

needed access-control protocols so that specific users' privileges with respect to a

document may be defined; col. 6, lines 35-46 group's security information); or wherein

when a user generates a request to perform a particular operation, determining whether

a user may access the document and data(col. 6, lines 35-46 - user's registered to

access and use the DMS system, user group information, ie, document rights for the

group), the level of access (col. 9, lines 19-32 types of access), determining the user's

one or more roles (groups) associated with the set of permissions, and determining if

the user can perform the operation requested on the document (col. 3, lines 7-12 –

provide needed access control protocols for example, so that specific users' privileges

with respect to a document may be defined; col. 3, lines 32-41 – the server is

programmed to perform a security function to verify or define a requestor's ability to

access an electronic document ;col. 6, lines 20-45 document group rights/ document

rights for the group; col. 11, lines 29-34) (col. 12, lines 24-37).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate into the disclosure of Takano the teachings of Serbinis so as to

provide collaborative file sharing and workflow, document delivery and document distribution and to provide needed access-control protocols so that specific users' privileges with respect to a document may be defined.

Referring to Claim 4:

Both Takano and Serbinis disclose a method wherein the users exchange documents with the server via the Internet (Takano col. 5, lines 45-51) (Serbinis col. 4, lines 30-63, Fig. 1A).

Referring to Claims 5-6:

It is unclear to the Examiner what the appellant is trying to claim here. It is old and well known to supply a correspondence mailing address when filing a patent application. It is unclear if the appellant is claiming an electronic address or a mailing address and if it is a mailing address, why?

Referring to Claim 7 and 9:

Takano and Serbinis disclose wherein documents are viewable over the Internet by some of the users as determined by an access management portion of the server (Takano col. 8, lines 15-19, col. 10, lines 20-21) (Serbinis col. 2, lines 41-43, col. 3, lines 10-13, col. 3, lines 32-41 – the server is programmed to perform a security function to verify or define a requestor's ability to access an electronic document, col.6, lines 19-46, col. 9, lines 19-33).

Referring to Claim 8:

Takano discloses a method in which there is a ready template data which make up a specification form for a patent application enabling the inventor to easily prepare a specification for the patent invention (col. 9, lines 46-51, Fig. 7).

Referring to Claims 11-13:

Takano a method wherein the patent application is filed in the patent office electronically (Fig. 18). It is old and well known to print the patent application on a printer and subsequently filed it with the patent office, or to include scanned versions of papers.

Referring to Claims 21 and 30:

Serbinis discloses a method wherein the electronic documents comprise word-processed document files, form-based document files and image files (col. 8, lines 62-67).

Referring to Claims 22 and 31:

Serbinis discloses a method wherein each electronic document has document meta data associated with the document (col. 9, lines 19-32).

Referring to Claims 23 and 32:

Serbinis discloses a method wherein each document meta data further identifies the history of each document (col. 9, lines 19-32).

Referring to Claims 24 and 33:

Serbinis discloses a method wherein the user cannot perform operation on the electronic document if the user is excluded by the unit level access information (col. 3,

lines 6-12 – it is common sense that if one does not have access information the user

cannot perform an operation, col. 9, lines 19-32 – types of access; Users may be

granted access only to retrieve and review a document, while others are granted access

to retrieve and modify the document.)

Referring to Claims 25 and 34:

Serbinis discloses a method wherein the user can perform the operation on the

document if the user is assigned permission and if the unit level access information

permits the user to perform the operation (col. 3, lines 6-12, col. 6, lines 19-46, col. 9,

lines 19-32) (See also Takano –col. 8, lines 14-18, col. 10, lines 20-23).

Referring to Claims 26 and 29:

Serbinis discloses a method wherein the plurality of groups are organized as a

hierarchy such that a group in the plurality of groups may contain one or more other

groups (col. 6, lines 19-46, col. 7, lines 16-27).

Referring to Claim 27:

Takano discloses. a method of managing electronic documents related to a

plurality of patent applications, the method comprising:

storing a plurality of collections of electronic documents and data on a computer-

readable memory operatively coupled to a server system (col. 5, lines 45-61), each

collection being associated with one of the plurality of patent applications and each

collection including data and one or more electronic documents related to its respective

patent applications (col. 6, lines 5-15, col. 7, line 54 thru col. 8, line 5 – plurality of

entities for registering plural pieces of invention report information) wherein each

collection is assigned to at least one group that can be used in determining whether a
user may access electronic documents and data in the particular collection, (col. 8, lines
14-18 – displaying on a display unit a list of all pieces of invention report information
registered in this table or only those satisfying specific conditions, e.g. only those
pertaining to inventors belonging to a specific department) and wherein the plurality of
collections of electronic documents includes at least a first collection associated with a
first patent application (col. 6, lines 5-15);

allowing a plurality of users to perform operations on electronic documents in the
plurality of collections of electronic documents and data (col. 8, lines 14-19, col. 10,
lines 20-23),

receiving a request from a first user to perform an operation on an electronic
document in the first collection (col. 8, line 7-26).

Takano does not disclose wherein each user is assigned to at least one group
that can be used in determining whether a user may access electronic documents and
data in a particular collection of electronic documents and wherein each user is
assigned one or more roles that are associated with a set of permissions that can be
used in determining if a user can perform a particular operation on a particular
electronic document in a collection or responsive to receiving the request, determining a
first group to which the first user is assigned; determining a second group to which the
document is assigned; determining one or more roles to which the first user is assigned
and determining if the user can perform the operation on the electronic document in the
first collection (document) based upon the first group to which the user is assigned, the

second group to which the first collection is assigned and the set of permissions associated with the one or more roles to which the user is assigned.

However, Serbinis discloses wherein each user is assigned to at least one group that can be used in determining whether a user may access electronic documents and data in a particular collection of electronic documents (col. 6, lines 19-46 document's parent document group information on the group of users that the user is a part of, including the group's security information and document rights for the group, col. 7, lines 16- 27 Fig. 3 is an illustrative *hierarchical* storage scheme for storing electronic documents. Each user has access to one or more document groups, where each document group comprises a collection of document objects) and wherein each user is assigned one or more roles (groups) that are associated with a set of permissions that can be used in determining if a user can perform a particular operation on a particular electronic document in a collection or responsive to receiving the request (col. 6, lines 35-46 (users registered access, **user group information**, ie, information on the group of users that the user is a part of, **including document rights for the group**, col. 9 lines 19-32, and col. 11, lines 21-35 – **user's rights also may be implied by the service selected**) determining if the user can perform the operation on the electronic document in the first collection (document) based upon the first group to which the user is assigned (col. 6, lines 35-46 **User group information document rights for the group**, the second group to which the first collection is assigned (col. 6, lines 19-34 – **document rights, document group rights** and the set of permissions associated with the one or more roles to which the user is assigned (col. 9, lines 19-33 -**the Originator**

specifies the types of access that each authorized user is to receive. Some users may be granted access only to retrieve and review a document while others are granted access to retrieve and modify the document)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the disclosure of Takano the teachings of Serbinis so as to provide collaborative file sharing and workflow, document delivery and document distribution and to provide needed access-control protocols so that specific users' privileges with respect to a document may be defined.

Referring to Claim 28:

Serbinis discloses a method wherein the first collection associated with the first patent application (document) includes unit level access information and wherein the step of determining if the user can perform the operation on the electronic document is based upon the level access information (col. 2, lines 41-43, col. 3, lines 10-13, col. 3, lines 32-41 – the server is programmed to perform a security function to verify or define a requestor's ability to access an electronic document; col. 6, lines 19-43, col. 9, lines 19-31).

Referring to Claim 20:

Takano discloses a system for managing intellectual property, the system comprising:

a processor (inherent in computer system manipulating data);

a computer readable memory coupled to the processor (col. 5, lines 45-51);

an invention disclosure creation component (col. 5, lines 55-61);

a patent application creation component (Fig. 18 (500));

a document management and access component (col. 7, line 51 thru col. 8, line 24);

a patent application filing component (Fig. 18)

Although Takano discloses that the system is connected to a plurality of computers (col. 1, lines 8-18) with a client computer used by a person of the patent application processing department of a company or a person of patent attorney's office (col. 6, lines 5-15), Takano does not disclose that the system is connected to a plurality of patent firm users with associated access rights. However, Serbinis discloses a document management system wherein the server is programmed to provide for a plurality of services supported by a common database and document store, including storage and retrieval services (a collaborative file sharing service programmed with a security function) (Fig. 1B, Figs. 2, 3). The fact that one set of the plurality of computers are in patent law firms does not effect the document management system that permits users to collaboratively store, retrieve, modify and then return an electronic document to an Internet-based storage site. Therefore, it would have been obvious to one of ordinary skill in the art to have the plurality of computers be in a plurality of law firms since this does not alter the structure of the system, i.e., a plurality of computers connected by a communication network, such as the Internet.

Takano does not disclose a document management and access component that maintains and enforces rights such that in response to receiving a request from a user to perform an operation determining a first group to which the first user is assigned;

determining a second group to which the document is assigned; determining one or

more roles to which the first user is assigned and determining if the user can perform

the operation on the electronic document in the first collection (document) based upon

the first group to which the user is assigned, the second group to which the first

collection is assigned and the set of permissions associated with the one or more roles

to which the user is assigned.

However, Serbinis discloses responsive to receiving the request (col. 6, lines 35-

46 (users registered access, **user group information**, ie, information on the group of

users that the user is a part of, **including document rights for the group,** col. 9 lines

19-32, and col. 11, lines 21-35 – **user's rights also may be implied by the service**

selected) determining if the user can perform the operation on the electronic document

in the first collection (document) based upon the first group to which the user is

assigned (col. 6, lines 35-46 **User group information document rights for the group,**

the second group to which the first collection is assigned (col. 6, lines 19-34 –

document rights, document group rights and the set of permissions associated with

the one or more roles to which the user is assigned (col. 9, lines 19-33 **-the Originator**

specifies the types of access that each authorized user is to receive. Some users

may be granted access only to retrieve and review a document while others are

granted access to retrieve and modify the document)

It would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate into the disclosure of Takano the teachings of Serbinis so as to

provide collaborative file sharing and workflow, document delivery and document

distribution and to provide needed access-control protocols so that specific users'

privileges with respect to a document may be defined.

(10) Response to Argument

Issue: The cited references fail to teach each element of any claim at issue

on appeal.

Appellant states that, as noted in the amendment dated July 13, 2004 (shown in

eDan as July 15, 2004), Takano is directed to a system for preparing patent applications

for a single entity or company. The appellant further asserts that there is no disclosure

or suggestion that Takano's system can be used to create invention disclosures and

patent applications and track other related electronic documents associated with the

same *for multiple, unrelated companies or technology developers* and thus,

Takano provides no disclosure for any access controls for protecting invention

disclosures, patent applications, or other documents from access by unauthorized

persons since Takano does not envision a situation in which *multiple independent*

entities might have access to Takano's system.

In response to appellant's argument that the references fail to show certain

features of appellant's invention, it is noted that the features upon which appellant relies

(i.e., *for multiple, unrelated companies or technology developers or multiple*

independent entities) are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into

the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The claims language reads as follows:

for a plurality of different and unrelated technology developers, allowing users

from each such technology developer to create a plurality of invention disclosures for

each respective technology developer.

The language "different and unrelated technology developers" is very broad.

MPEP 2111 requires the Examiner to give claims the broadest reasonable interpretation

consistent with the supporting description without reading limitations into the claims.

The Merriam Webster online dictionary found on onelook.com defines "plurality,"

and "different" as:

Different

Main Entry: ¹**dif·fer·ent** ◀⁾
Pronunciation: 'di-f&rnt, 'di-f(&-)r&nt
Function: *adjective*
Etymology: Middle French, from Latin *different-, differens,*
present participle of *differre*
1 : partly or totally unlike in nature, form, or quality :
DISSIMILAR <could hardly be more *different>* -- often
followed by *from, than,* or chiefly British *to* <small, neat
hand, very *different* from the captain's tottery characters --
R. L. Stevenson> <vastly *different* in size than it was
twenty-five years ago -- N. M. Pusey> <a very *different*
situation to the ... one under which we live -- Sir Winston
Churchill>
2 : not the same: as **a** : **DISTINCT** <*different* age groups> **b**
: **VARIOUS** <*different* members of the class> **c** : **ANOTHER**
<switched to a *different* TV program>
3 : **UNUSUAL, SPECIAL** <she was *different* and superior>
- **dif·fer·ent·ness** *noun*
synonyms DIFFERENT, DIVERSE, DIVERGENT, DISPARATE,
VARIOUS mean unlike in kind or character. DIFFERENT may
imply little more than separateness but it may also imply

contrast or contrariness <*different* foods>. DIVERSE implies both distinctness and marked contrast <such *diverse* interests as dancing and football>. DIVERGENT implies movement away from each other and unlikelihood of ultimate meeting or reconciliation <went on to pursue *divergent* careers>. DISPARATE emphasizes incongruity or incompatibility <*disparate* notions of freedom>. VARIOUS stresses the number of sorts or kinds <tried *various* methods>.

usage Numerous commentators have condemned *different than* in spite of its use since the 17th century by many of the best-known names in English literature. It is nevertheless standard and is even recommended in many handbooks when followed by a clause. *Different from,* the generally safe choice, is more common and is even used in constructions where *than* would work more smoothly.

plurality

One entry found for **plurality**.
Main Entry: **plu·ral·i·ty** □
Pronunciation: plu-'ra-l&-tE
Function: *noun*
Inflected Form(s): *plural* **-ties**
1 a : the state of being plural **b :** the state of being numerous **c :** a large number or quantity
2 : PLURALISM 1; *also* : a benefice held by pluralism
3 a : a number greater than another **b :** an excess of votes over those cast for an opposing candidate **c :** a number of votes cast for a candidate in a contest of more than two candidates that is greater than the number cast for any other candidate but not more than half the total votes cast

Onelook.com defines unrelated as:

Quick definitions (*unrelated*)

- *adjective*:   not connected by kinship
- *adjective*:   not connected or associated

Takano discloses a system, method and program with inventors and persons in charge of filing patent applications using a plurality of computers connected to a communication network, such as the Internet, for preparing patent specifications for patent applications. Thus, the claim language "a plurality of different and unrelated technology developers" is broad enough to encompass two or more employees or personnel connected to each other via a network. Since claims must be given their broadest reasonable interpretation consistent with the supporting description, interpreting the term *unrelated technology developers* could define inventors which are in different departments within a company, or inventors connected to attorneys.

Takano and Serbinis, in combination, disclose a method and system for Internet-based document management wherein an electronic document may be stored on an Internet-accessible server and accessed using a web browser, downloaded for review or manipulation and returned to the server for access by further users with needed access control protocols (column 3, lines 7-19 of Serbinis).

Takano and Serbinis disclose a plurality of computer connected via a network. The fact that one set of the plurality of users of the computers are patent law firms or unrelated companies does not effect the document management method that permits users to collaboratively store, retrieve, modify and then return an electronic document to an Internet-based storage site as set forth in Takano and Serbinis (Takano –col. 1, lines

8-18; col. 5, lines 45-51; col. 7, lines 27-34; col. 7, line 64 thru col. 24; Serbinis col. 2,

lines 63-67).

Takano discloses a method and system using a *plurality* of computers

connected to a communication network, such as the Internet, for preparing patent

specifications for patent applications (col. 1, lines 8-18).   Takano discloses that an

object of the invention is to provide a system capable of preparing data for patent

application documents by the transmission and receptions of draft data via a server

computer between a client computer used by an inventor preparing the draft data for a

specification to be included in his or her patent application and another client computer

used by patent-application-filing persons including a patent attorney revising the draft

data. Takano discloses in column 8, lines 7-24 that:

> Upon registration of the draft data for the specification for patent
> application and the pertinent piece of invention report information into the
> server computer 300 as described above, the patent-application-filing persons
> are enabled to revise the draft data on the client computer 200. When the
> draft is to be revised, first the draft downloading means 201 of the computer
> 200 references the specification file management table 304 in the specification
> file 303 of the server computer 300; displays on a display unit (not shown) a
> list of all the pieces of invention report information registered in this table
> 304 (*or only those satisfying specific conditions [e.g. only those pertaining
> to inventors belonging to a specific department]*) (step A9); lets the
> patent-application-filing persons select a desired piece of invention report
> information; finds the storage address of the draft data pertaining to the
> selected piece of invention report information from the specification file
> management table 304; and reads the draft data from the specification file 303
> on the basis of that address (step A10).

> In column 10, lines 8-29, Takano discloses:

> After the completion of entry procedure of processing by the draft entry

means 302 (step A14 in FIG. 2), the inventor checks the contents of the revised draft data thereby entered, and if he or she is to make any required correction (in this embodiment, for the sake of convenience, supplementation and/or correction done by the inventor is referred to as "checking," and those by the patent-application-filing persons, as "revision"), first the draft downloading means 106 in the client computer 100 refers to the specification file management table 304 in the specification file 303 of the server computer 300; displays on the display unit (not shown) a list of all the pieces of invention report information registered in this table 304 (*or only those satisfying specific conditions [e.g. only those pertaining to the inventor concerned]*) (step C1 in FIG. 9); lets the inventor select a desired piece of invention report information; finds the storage address of the draft data pertaining to the selected piece of invention report information from the specification file management table 304; and reads the revised draft data from the specification file 303 on the basis of that address (step C2). Here, the list displayed on the display unit is similar to that illustrated in FIG. 5.

Thus, Takano discloses a method and system for managing electronic documents among a plurality of different and unrelated users with access controls.

As for appellant's assertion that the Examiner acknowledged that there is no disclosure in Takano of maintaining and enforcing access rights among multiple law firms to patent application data stored in a common repository, the Examiner submits the following.

Although Takano discloses that the system is connected to a plurality of computers connected via a communication network, such as the Internet (col. 1, lines 8-18), and Takano discloses a system connecting inventors and patent attorney offices (col. 2, lines 3-10 and col 6, lines 5-15), Takano does not disclose that the system is connected to a plurality of patent firm users with associated access rights. However, Serbinis teaches a document management system wherein the server is programmed to provide for a plurality of services supported by a common database and document

store, including storage and retrieval services (a collaborative file sharing service

programmed with a security function (Figures 1B, 2 and 3). The Examiner asserts that

the fact that the users are patent law firms does not affect that document management

system that permits users to collaboratively store, retrieve, modify and return an

electronic document to an Internet-based storage site.

The appellant states that Serbinis has nothing to do with the preparation of

patent applications. The Examiner agrees with this assertion.

In response to appellant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986). Takano discloses the preparation of patent applications. As stated on page 9 of

the appellant's brief, Serbinis is directed to a web-based system for allowing document

storage, collaborative file sharing and workflow, document delivery and document

distribution. Furthermore, the Examiner asserts that a patent is a document and

Serbinis in combination with Takano discloses preparation of a patent document.

The Examiner agrees with the appellant's assertion on page 9 of the appeal brief

that Serbinis provides a number of access-control and security facilities.

Appellant argues that Takano and Serbinis, taken together, fail to teach or

suggest the elements of the pending claims, *which are directed generally to methods*

and systems for managing intellectual property for a plurality of unrelated

entities. As discussed above the Examiner disagrees with this assertion and submits

that Takano and Serbinis, taken together, are directed to methods and systems for

managing intellectual property for a plurality of unrelated entities/users with access to

the patent application-related documents being managed.

Issue: Takano and Serbinis each fail to teach or suggest user roles.

The appellant asserts that neither Takano nor Serbinis teach the use of

permissions in user roles to determine whether a user can perform an operation on an

electronic document.

Claim 19 has the following claim language:

A method of managing electronic documents related to a plurality of patent

applications, the method comprising:

for a plurality of different and unrelated technology developers, allowing

users from each such technology developer to create a plurality of invention disclosures

for each respective technology developer;

receiving the plurality of invention disclosures from the users from each

technology developer at a server system over a network and storing each invention

disclosure in one of a plurality of collections of electronic documents and data in a

computer-readable memory operatively coupled to the server system, wherein each

collection is associated with one of the plurality of patent applications and *assigned to*

at least one group that can be used in determining whether a user may access

electronic documents and data in the particular collection;

storing, in the database, additional electronic documents associated with at

least some of the plurality of invention disclosures for each technology developer;

maintaining and enforcing rights to electronic documents in the plurality

of collections of electronic documents such that at least some users associated with

each technology developer in the plurality of technology developers can access

selected ones of the electronic documents associated with invention disclosures created

for the respective technology developer and such that users associated with a particular

technology developer cannot access electronic documents in the database associated

with invention disclosures of other unrelated technology developers' in the plurality of

technology developers;

maintaining and enforcing rights to electronic documents in the plurality

of collections of electronic documents for users associated with a plurality of patent

firms such that at least some users from selected ones of the patent firms have rights to

view selected invention disclosures stored in the collections and selected electronic

documents stored in the collection selected invention disclosure is stored in and create

and modify patent applications prepared for the selected invention disclosures;

receiving any such created patent application at the server system and

storing it in the collection of electronic documents the respective invention disclosure is

stored in;

maintaining and enforcing rights to file patent applications in a patent

office for users associated with the plurality of law firms such that only selected users

from the law firms have rights to file patent applications in the patent office; and

electronically receiving a request from a user to file a particular patent

application for a first technology developer in the plurality of technology developers,

determining if the client system has appropriate rights to file the particular patent

application and, if so, causing the patent application to be filed in the patent office in

response to the request;

wherein each user from the plurality of different and unrelated technology

developers and each user from the plurality of patent law firms is assigned to at least

one group that can be used in determining whether a user may access electronic

documents and data in a particular collection of electronic documents and **wherein**

each user is assigned one or more roles that are associated with a set of

permissions that can be used in determining if a user can perform a particular

operation on a particular electronic document in a collection, and

wherein when a user generates a request to perform an operation on an

electronic document in a particular collection of electronic documents, in response to

receiving the request, determining (i) a first group to which the user is assigned', (ii) a

second group to which the electronic document assigned; (iii) **one or more roles to**

which the user is assigned. (iv) unit level access information for the particular

collection of electronic documents and (v) if the user can perform the operation on the

electronic document based upon the first group to which the user is assigned, the

second group to which the particular collection of electronic documents is assigned, **the**

set of permissions associated with the one or more roles to which the user is

assigned and the unit level access information for the particular collection of electronic

documents

Claim 20 is directed to a server system comprising:

a processor;

a computer-readable memory, coupled to the processor, for storing a
plurality of collections of electronic documents and data related to a plurality of invention
disclosures for a plurality of different and unrelated technology developers, wherein the
plurality of electronic documents include invention disclosures, patent applications and
additional documents associated with the invention disclosures and/or patent
applications;

an invention disclosure creation component that allows users from each of
the plurality of technology developers to create invention disclosures for the respective
technology developer each client system is associated with and store the invention
disclosures in the database as electronic documents,

a patent application creation component that allows users associated with a
plurality of patent firms to create and modify patent applications prepared for selected
invention disclosures stored in the database and store the patent applications in the
database as electronic documents;

a document management and access component that maintains and
enforces rights to electronic documents in the database such that, in response to
receiving a request from a user to perform an operation on an electronic document in a
particular collection of electronic documents, determining (i) a first group to which the
user is assigned; (ii) a second group to which the electronic document assigned; (iii)

one or more roles to which the user is assigned (iv) unit level access information for

the particular collection of electronic documents and (v) if the user can perform the

operation on the electronic document based upon the first group to which the user is

assigned, the second group to which the particular collection of electronic documents is

assigned, *the set of permissions associated with the one or more roles to which*

the user is assigned and the unit level access information for the particular collection

of electronic documents, and

a patent application filing component that, in response to receiving a

request from a user to perform an operation of filing a particular patent application,

causes the patent application to be filed in the patent office if the document

management and access component determines the user has sufficient rights to

perform the filing operation.

Claim 27 is directed to a method comprising:

storing a plurality of collections of electronic documents and data on a

computer-readable memory operatively coupled to a server system, each collection

being associated with one of the plurality of patent applications and each collection

including data and one or more electronic documents related to its respective patent

application, wherein each collection is assigned to at least one group that can be used

in determining whether a user may access electronic documents and data in the

particular collection, and wherein the plurality of collections of electronic documents

includes at least a first collection associated with a first patent application;

allowing a plurality of users to perform operations on electronic

documents in the plurality of collections of electronic documents and data, wherein each

user is assigned to at least one group that can be used in determining whether a user

may access electronic documents and data in a particular collection of electronic

documents and *wherein each user is assigned one or more roles that are*

associated with a set of permissions that can be used in determining if a user can

perform a particular operation on a particular electronic document in a collection;

receiving a request from a first user to perform an operation on an

electronic document in the first collection; and

responsive to receiving the request, determining a first group to which the

first user is assigned; determining a second group to which the first collection is

assigned; *determining one or more roles to which the first user is assigned and*

determining if the user can perform the operation on the electronic document in

the first collection based upon the first group to which the user is assigned, the

second group to which the first collection is assigned and *the set of permissions*

associated with the one or more roles to which the user is assigned.

Appellant admits, page 10 of the appeal brief, that Serbinis teaches the use of a

variety of access control mechanisms, including user-level, group-level access controls,

and directs the Board to column 6, lines 41-45, teaching "user group information, i.e.,

information on the group, the group's security information, and document rights of the

group. Appellant then argues that Servinis doe not teach any user roles other than

group membership, and in particular Serbinis does not teach that any specific

permissions might be associated with such roles.

Once again, the Examiner reminds appellant that MPEP 2111 requires the

Examiner to give claims the broadest reasonable interpretation consistent with the

supporting description without reading limitations into the claims.

Appellant identifies roles in the specification, paragraphs [0060-0062] as:

[0060] As stated above, access management system 109 provides security
services for the patent-related information in system 100. According to an
embodiment of the invention, the access management system is a gateway,
either allowing or disallowing various operations to be performed upon data
and/or documents associated with a case. According to one embodiment,
access management system 109 either allows or disallows users to perform
operations upon a Case Data Unit according to rules and permissions assigned
to a user, as well as groups assignment of both users and Case Data Units.
Other embodiments of the access management system further provide Case
Data Unit level access information.

[0061] Access management system 109 assigns users (client systems) of system
100 and Case Data Units to one or more groups. A user assigned to a group will
have access to the Case Data Units in that group and any subsets of the group.
Similarly, users not assigned to the group will not have access to Case Data
Units in that group. Examples of specific groups may include: Company X,
Division M of Company X, Division of N of Company X, law firm Y, client team R
in law firm Y, or any other logical groupings of related client systems.

[0062] In addition to user groups, system 100 assigns each user one or more
roles, such as system administrator, docketing administrator, inventor,
responsible practitioner, working practitioner and secretary among others.
*Users can be automatically assigned to groups based upon their role or a
user can be manually added to a group. Further, users can be excluded
from a group automatically based upon their role or can be manually
excluded. While assignment to a group allows a user to access Case Data
Units of the same group, it does not necessarily provide full access to all
data and/or documents in Case Data Units of the group. Such access is
also governed by the user's role.*

[0063] To this end, each of the various roles attached to a user has associated
with it a set of default permissions. A user assigned a given role is also

assigned the default permissions associated with the role. Permissions provide for given tasks to be performed upon the data and/or information of a Case Data Unit. Assignable permissions include, for example, creating, modifying, and deleting cases; creating, modifying, and deleting select case meta data associated with a case; creating, modifying and deleting notes associated with a case; creating, modifying and deleting patent documents associated with a case; viewing and/or printing various documents and/or data from a case; and purging a case of unnecessary documents (e.g., rough drafts of application, unnecessary notes and the like) among other permissions. In addition to the default permissions associated with a given role, other available permissions may be assigned or deassigned to the role thus providing for customization of the permissions individual users are assigned.

[0064] Roles, in turn, have default sets of documents types assigned to them. The assignment of a given document type to a given role allows a user assigned the given role to make certain manipulations upon documents of that type. Specific examples of document types include an invention disclosure, a filed patent application, patent drawings, old versions of patent applications and drawings, other patent papers (e.g., other documents filed in the patent office including: responses to office actions, information disclosure statements, petitions, etc.); forms, image files (e.g., locked documents of .pdf or a similar type of image file format corresponding to a granted patent (if a patent was granted for the case) as well as image file format copies of any office actions received, responses filed in the patent office, filing receipts, etc. issued during prosecution of the patent application); notes (e.g., practitioner notes, inventor notes, notes from other interested parties regarding the importance of the patent to a company's business, products or competitor's business or products, etc.); mail (e.g., email messages or alerts) and prior art references among others.

Serbinis teaches access-control protocols, for example, so that specific users'

privileges with respect to a document may be defined (col. 3, line 7-13).

Serbinis discloses in column 6, lines 35-46:

User information tables 62 have entries for information relating to
users registered to access and use the DMS system, including: the name of
the user; logon information for the user, e.g., user ID and password; user
notification information, e.g., notification address and transport type;
billing code information; information on the user's account, where each user
account is unique to a service account and user; user session information; and
user group information, i.e., information on the group of users that the user

> *is a part of, including the name of the group, the state of the group, the group's security information, and document rights for the group.*

Serbinis discloses permissions in column 9, lines 19-32:

> The Originator then fills out appropriate forms indicating a desire to upload the previously created electronic document to the DMS system, and at step 82 defines a list of Authorized Users who may access the document. The Originator specifies the *types of access that each Authorized User* is to receive, and metadata concerning the document (e.g., expiration date, etc.). *Thus, for example, some Authorized Users may be granted access only to retrieve and review a document, while others are granted access to retrieve and modify the document.* The specific access rights granted to each Authorized User are recorded in the document tables of DMS database 25, and the transaction is logged in the transaction tables of DMS database 25.

Serbinis discloses a set of permissions associated with information on groups of users (col. 6, lines 19-45) and Serbinis discloses Originator and Authorized users (col. 9, lines 19-32). The Examiner asserts that a user role can be defined by the name of the user, i.e., Originator and Authorized user, or by the user group. The access granted to the users are the permissions, i.e., retrieve and review document or retrieve and modify the document (col. 9, lines 19-32 types of access).

Furthermore, Takano discloses in column 8, lines 7-24:

> When the draft is to be revised, first the draft downloading means 201 of the computer 200 references the specification file management table 304 in the specification file 303 of the server computer 300; displays on a display unit (not shown) a list of all the pieces of invention report information registered in this table 304 (*or only those satisfying specific conditions [e.g. only those pertaining to inventors belonging to a specific department]*) (step A9); lets the patent-application-filing persons select a desired piece of invention report information; finds the storage address of the draft data pertaining to the selected piece of invention report information from the specification file management table 304; and reads the draft data from the specification file 303 on the basis of that address (step A10).

In column 10, lines 8-29, Takano discloses:

After the completion of entry procedure of processing by the draft entry
means 302 (step A14 in FIG. 2), the inventor checks the contents of the revised
draft data thereby entered, and if he or she is to make any required correction
(in this embodiment, for the sake of convenience, supplementation and/or
correction done by the inventor is referred to as "checking," and those by the
patent-application-filing persons, as "revision"), first the draft downloading
means 106 in the client computer 100 refers to the specification file
management table 304 in the specification file 303 of the server computer 300;
displays on the display unit (not shown) a list of all the pieces of invention
report information registered in this table 304 (*or only those satisfying
specific conditions [e.g. only those pertaining to the inventor concerned*])
(step C1 in FIG. 9); lets the inventor select a desired piece of invention
report information; finds the storage address of the draft data pertaining to
the selected piece of invention report information from the specification file
management table 304; and reads the revised draft data from the specification
file 303 on the basis of that address (step C2). Here, the list displayed on
the display unit is similar to that illustrated in FIG. 5.

Thus, Takano discloses permissions associated with user roles – only the

inventor concerned or the inventors belonging to a specific department are allowed to

select a desired piece of invention report information displayed.

Issue: Takano and Serbinis fail to teach or suggest the recited

combination of permission.

Claims 19 and 20 are directed to a method and system comprising the following

limitation:

when a user generates a request to perform an operation on an

electronic document in a particular collection of electronic documents, in response to

receiving the request, determining (i) a first group to which the user is assigned, (ii) a

second group to which the electronic document assigned; (iii) one or more roles to

which the user is assigned. (iv) unit level access information for the particular collection

of electronic documents and (v) if the user can perform the operation on the electronic

document based upon the first group to which the user is assigned, the second group to

which the particular collection of electronic documents is assigned, the set of

permissions associated with the one or more roles to which the user is assigned and the

unit level access information for the particular collection of electronic documents.

Claim 27 is directed to a method comprising the following limitation:

allowing a plurality of users to perform operations on electronic

documents in the plurality of collections of electronic documents and data, *wherein each*

user is assigned to at least one group that can be used in determining whether a user

may access electronic documents and data in a particular collection of electronic

documents and wherein each user is assigned one or more roles that are associated

with a set of permissions that can be used in determining if a user can perform a

particular operation on a particular electronic document in a collection;

receiving a request from a first user to perform an operation on an

electronic document in the first collection; and

responsive to receiving the request, *determining a first group to which the*

first user is assigned; determining a second group to which the first collection is

assigned; determining one or more roles to which the first user is assigned and

determining if the user can perform the operation on the electronic document in the first

collection based upon the first group to which the user is assigned, the second group to

which the first collection is assigned and the set of permissions associated with the one

or more roles to which the user is assigned.

Appellant argues that neither Takano nor Serbinis teach or suggest the

appellant's particular procedure for maintaining and enforcing rights to access electronic

documents. The appellant argues that neither Takano nor Serbinis discloses combining

three different data (user group information, document group information and user role

information) in making a determination as to whether or not a particular user can

perform a particular operation.

The Examiner respectfully disagrees with this assertion. Takano discloses in

column 8, lines 7-24:

> When the draft is to be revised, first the draft downloading means 201 of the
> computer 200 references the specification file management table 304 in the
> specification file 303 of the server computer 300; displays on a display unit (not
> shown) a list of all the pieces of invention report information registered in this
> table 304 (*or only those satisfying specific conditions [e.g. only those
> pertaining to inventors belonging to a specific department*]) (step A9); lets
> the patent-application-filing persons select a desired piece of invention report
> information; finds the storage address of the draft data pertaining to the
> selected piece of invention report information from the specification file
> management table 304; and reads the draft data from the specification file 303
> on the basis of that address (step A10).

In column 10, lines 8-29, Takano discloses:

> After the completion of entry procedure of processing by the draft entry
> means 302 (step A14 in FIG. 2), the inventor checks the contents of the revised
> draft data thereby entered, and if he or she is to make any required correction
> (in this embodiment, for the sake of convenience, supplementation and/or
> correction done by the inventor is referred to as "checking," and those by the
> patent-application-filing persons, as "revision"), first the draft downloading
> means 106 in the client computer 100 refers to the specification file
> management table 304 in the specification file 303 of the server computer 300;
> displays on the display unit (not shown) a list of all the pieces of invention

report information registered in this table 304 (*or only those satisfying specific conditions [e.g. only those pertaining to the inventor concerned]*) (step C1 in FIG. 9); lets the inventor select a desired piece of invention report information; finds the storage address of the draft data pertaining to the selected piece of invention report information from the specification file management table 304; and reads the revised draft data from the specification file 303 on the basis of that address (step C2). Here, the list displayed on the display unit is similar to that illustrated in FIG. 5.

Thus, the Examiner asserts that Takano discloses user role information used to control access to data, i.e., only inventors belonging to a specific department.

Moreover Serbinis discloses in column 6, lines 19-46 the following:

Referring to FIG. 2, DMS database 25 is described in greater detail. Database 25 includes a plurality of tables 61-64 and 66-68 that maintain information on documents stored in store 30. Each of tables 61-64 and 66-68 may in turn consist of multiple tables. Document information tables 61 have entries for a number of document-related parameters, including: information on a document's parent document group; information on the document instances; information on the transport method to be used for retrieval of a document instance; information on the priority of the document; expiration information: the date and time when a document instance is changed from "active" status to "archived" status; workflow information for a document instance; *security information; document rights; and document group rights.*

User information tables 62 have entries for information relating to users registered to access and use the DMS system, including: the name of the user; logon information for the user, e.g., user ID and password; user notification information, e.g., notification address and transport type; billing code information; information on the user's account, where each user account is unique to a service account and user; user session information; and *user group information, i.e., information on the group of users that the user is a part of, including the name of the group, the state of the group, the group's security information, and document rights for the group.*

Thus, the Examiner asserts that there is disclosure in Serbinis for combining

three different data in making a determination as to whether or not a particular user can

perform a particular operation (Figure 2).

Serbinis discloses determining (i) a first group to which the user is assigned

(Figure 2 (62) User information User group information, (ii) a second group to which the

electronic document assigned (Figure 2 (61) (Document information; col. 6, lines 19-33

document related parameters; (iii) one or more roles to which the user is assigned (col.

6, lines 34-46 user group information, i.e., information on the group of users that the

user is a part of, including group name, the state of the group) (iv) unit level access

information for the particular collection of electronic documents (document security

information and Rights (document rights and document group rights)) and (v) if the user

can perform the operation on the electronic document based upon the first group to

which the user is assigned (col. 6, lines 34-46 document rights of the group), the second

group to which the particular collection of electronic documents is assigned (col. 6, lines

19-34 document rights and document group rights), the set of permissions associated

with the one or more roles to which the user is assigned (col. 6, lines 34-46 user group

information, document rights of the group) and the unit level access information for the

particular collection of electronic documents (document rights and document group

rights).

Furthermore, in column 9, lines 19-31, Serbinis discloses:

The Originator then fills out appropriate forms indicating a desire to
upload the previously created electronic document to the DMS system, and at
step 82 *defines a list of Authorized Users who may access the document.*
The Originator *specifies the types of access that each Authorized User is to*

receive, and metadata concerning the document (e.g., expiration date, etc.). Thus, for example, some Authorized Users may be granted access only to retrieve and review a document, while others are granted access to retrieve and modify the document. *The specific access rights granted to each Authorized User are recorded in the document tables of DMS database 25*, and the transaction is logged in the transaction tables of DMS database 25.

Referring to FIG. 2 of Serbinis, DMS database 25 includes a plurality of tables 61-64 and 66-68 that maintain information on documents stored in store 30. Each of tables 61-64 and 66-68 may in turn consist of multiple tables with entries for a number of document-related parameters including security *information; document rights; and document group rights.* User information tables 62 have entries for information relating to users registered to access and use the DMS system, including: the name of the user; logon information for the user, e.g., user ID and password; and *user group information, i.e., information on the group of users that the user is a part of, including the name of the group, the state of the group, the group's security information, and document rights for the group.* Furthermore, the Originator *defines a list of Authorized Users who may access the document and specifies the types of access that each Authorized User is to receive,*

Issue: Takano and Serbinis fail to teach or suggest determining rights to file a patent application.

Claim 19 is directed to a method comprising:

electronically receiving a request from a user to file a particular patent application for a first technology developer in the plurality of technology developers,

determining if the client system has appropriate rights to file the particular patent application and, if so, causing the patent application to be filed in the patent office in response to the request

Claim 20 is directed to a server system comprising:

a patent application filing component that, in response to receiving a request from a user to perform an operation of filing a particular patent application, causes the patent application to be filed in the patent office if the document management and access component determines the user has sufficient rights to perform the filing operation.

Appellant argues that the cited portions of Takano do not describe how a patent application might be transmitted to a patent office. Appellant further argues that Takano does not teach or suggest determining if the client system has appropriate rights to file the particular patent application and, if so, causing the patent application to be filed in the patent office.

First, Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the appellant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the appellant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Takano discloses:

The present invention relates to a system for preparing patent specifications, a method for preparing patent specifications, and a storage medium recording thereon a program for preparing patent specifications, and more particularly to a system for preparing patent specifications, a method for preparing patent specifications, and a storage medium recording thereon a program for preparing patent specifications with inventors and *persons in change of filing patent applications* using a plurality of computers connected to a communication network, such as Internet, for preparing patent specifications for patent applications (col. 1, lines 8-18).

An object of the present invention is to provide a system capable of preparing data for patent application documents by the transmission and reception of draft data via a server computer between a client computer used by an inventor preparing the draft data for a specification to be included in his or her patent application and *another client computer used by patent-application-filing persons* including a patent attorney revising the draft data (col. 2, lines 3-9).

The client computer 200 is used by a person of the patent application processing department of a company or a person of a patent attorney's office *requested by the company to file a patent application (hereinafter, persons will be collectively referred to as "patent-application-filing persons"),* who revise the draft data for the specification for patent application, prepared by the inventor, and *preparing the finalized specification data for the patent application to be filed with the Patent Office* (col. 6, lines 5-15).

Referring to FIG. 15, the sixth preferred embodiment of the invention includes, in addition to the configuration of the fifth embodiment, a client computer 500, and *the client computer 200 includes a patent application document data transmitting means 205*, a proof receiving means 206 and a proof transmitting means 207, while the server computer 300 includes a proof receiving means 305 and a proof entry means 306 (col. 15, lines 37-67).

The client computer 500, to be used by the Patent Office, comprises a patent application document data receiving means 501 and a proof transmitting means 502.

The patent application document data receiving means 501 receives patent application document data transmitted from the client computer 200.

The proof transmitting means 502 prepares a proof corresponding to the patent application document data received by the patent application document data receiving means 501, and transmits it to the client computer 200.

The client computer 200 further includes the patent application document data transmitting means 205, the proof receiving means 206 and the proof transmitting means 207.

The patent application data transmitting means 205 receives the draft data for the specification for patent application and the piece of invention report information on the draft data, transmitted from the draft uploading means 203, to the server computer 300, ***prepares patent application document data, and transmits them to the client computer 500***.

The proof receiving means 206 receives the proof transmitted from the client computer 500.

Upon completion of final revision of the draft data by the patent-application-filing persons, the draft uploading means 203 of the client computer 200 transmits the draft data and the piece of invention report information on the draft data to the server computer 300 and, at the same time, delivers the draft data and the piece of invention report information on the draft data to the to the patent application document data transmitting means 205 (step F1 in FIG. 16) (col. 16, lines 26-44).

The patent application document data transmitting means 205 receives from the draft uploading means 203 the draft data and the piece of invention report information on the draft data (step F2), ***extracts from the piece of invention report information items necessary for the preparation of a patent application*** (including the inventor's name and the title of the invention) ***to prepare document data for the patent application*** (step F3), ***and transmits the draft data for the specification for patent application, accompanied with the document data on the application, to the client computer 500 as patent application document data*** (step F4).

Appellant is also directed to col. 19, lines 44-48 wherein Takano discloses:

a patent application document sending means for sending an application form and said revised draft data for filing with the United States Patent and Trademark Office as patent application document data to a computer of the United States Patent and Trademark Office

Thus, the Examiner asserts that the patent application filing component is the

component that transmits the document data on the application to the client computer

500 as patent application document data. Therefore, Takano discloses receiving a

request from a user to file a particular patent application (col. 6, lines 5-15 the client

computer 200 is used by a person of the patent application processing department of a

company or a person of a patent attorney office *requested* by the company to file a

patent application). Since appellant's specification does not disclose how or what

makes the determination of whether the client system has appropriate rights to file the

patent application, the Examiner will broadly interpret this language. Takano discloses

that upon completion of final revision of the draft data by the patent-application-filing

persons, *the draft uploading means 203 of the client computer 200 transmits the*

draft data and the piece of invention report information on the draft data to the

server computer 300 and, at the same time, delivers the draft data and the piece

of invention report information on the draft data to the patent application

document data transmitting means 205 (step F1 in FIG. 16) (col. 16, lines 26-44).

Thus, the draft uploading means 203 delivers the draft data to the application document

transmitting means 205. By virtue of the fact that this is the document transmitting

means would indicate that this computer has rights to file the patent application.

Issue: Takano and Serbinis fail to teach or suggest presenting questions to a user.

Dependent claim 8, which depends on claim 19, is directed to *wherein the plurality of disclosures are generated by responding to questions presented to users in the first plurality of users by the server via a Web page.*

The appellant argues that providing a template for a specification form, as disclosed in Takano, is in no way similar to presenting questions to be answered by an inventor. The appellant then states that the novel feature of certain embodiments provides may more benefits than merely presenting a template for a user, for instance, the questions can be phrased in an easy-to-understand manner, reducing the intimidation many inventors face when attempting to disclose an invention. Appellant goes on to state that by contrast, the system of Takano merely "reads the template data fetched by the template down loading means 105 into the text preparation software and completes the draft data for the specification for patent application by having the invention enter the text data in addition to template data. That is, Takano's template system simply provides some data for the user and then requires the user to enter additional information.

The Examiner directs the appellant to the following section of Takano.

Referring to FIG. 6, in the second preferred embodiment of the invention, the client computer 100 further includes a template downloading means 105. (col. 9, lines 11-22)

This template downloading means 105 reads in document data in a specification form for patent application stored in advance in the specification file 303 of the server computer 300 (*a form in which the titles*

*of various items and sentence patterns frequently used in a specification
are arranged in their respectively prescribed positions so as to allow the
specification to be completed by entering sentences to fill blanks*)
(hereinafter called "template data").

Thus, the Examiner asserts that Takano discloses the limitation *wherein the*

invention disclosure is generated by responding to questions/entering sentences to fill

blanks.   Appellant is also directed to Figure 3 wherein an invention report information

screen is shown with input fields (col. 7, lines 11-26). Takano in combination with

Serbinis disclose wherein the questions/entering sentence to fill blank can be presented

via a website (col. 2, lines 3-20 While it is known in the art to use an Internet web

browser to download an electronic document from a website, using, for example, Hyper

Text Transfer Protocol ("HTTP") or File Transfer Protocol ("FTP"), there currently do not

exist document management systems that permit such a file to be modified by a user,

and uploaded to the system for further collaborative retrieval and modification by others.

In view of the foregoing it would be desirable to provide a document management

system and methods that permit electronic documents to be made available for use on

open systems, such as the Internet, and to be accessed using a previously known web

browser--without the need for a specialized client application. It also would be desirable

to provide an Internet-based document management system and methods that permit

users to access a plurality of services supported by a common Internet-based database,

including document storage, collaborative file sharing and workflow, document delivery

and document distribution).

Issue: The Final Office Action establishes no motivation or suggestion to combine Takano and Serbinis.

Appellant states that Takano is directed to a closed system comprising a server and proprietary clients for use by a single entity.

First of all, it is not clear what appellant means by a closed system. The Examiner does not find this terminology in Takano's disclosure. Secondly, the Examiner is unable to find where Takano defines the invention as being proprietary clients for a single entity.

Appellant states that Takano is a closed system in contrast to Serbinis which is directed to an open, web-browser system. While trying to understand what the appellant is defining as a closed or open system, the Examiner finds the appellant's remarks to be contradictory. On page 18 of the brief appellant argues that:

> In contrast, also as noted above, Serbinis specifically teaches away from the use of dedicated client software, in favor of using a generic web browser. In fact, avoiding the use of dedicated client applications is the primary object of Serbinis's invention: "[I] is an object of this invention to provide a document management system and methods that permit electronic documents to be made available *for use on open systems, such as the Internet*, and to be accessed using previously known web browser--without the need for a specialized client application." Serbinis, c. 2, 11. 46-51. Serbinis later notes that a benefit of Serbinis's system is that it "enables DMS system 17 to interact with users through a web browser, rather than requiring specialized client software." 1d., c. 5, 11. 4-6. Hence, while Takano requires the use of a specialized client application, Serbinis is specifically directed to a system that avoids the use of such specialized software. Serbinis, therefore, teaches away from the combination asserted by the Final Office Action.

If the Internet defines an open system, then Takano is an open system. Takano states:

The present invention relates to a system for preparing patent specifications, a method for preparing patent specifications, and a storage medium recording thereon a program for preparing patent specifications, and more particularly to a system for preparing patent specifications, a method for preparing patent specifications, and a storage medium recording thereon a program for preparing patent specifications with inventors and persons in change of filing patent applications *using a plurality of computers connected to a communication network, such as Internet,* for preparing patent specifications for patent applications (col. 1, lines 8-18).

The appellant seems to argue that since Takano is directed to a closed system comprising a server for use by a single entity all necessary access controls are provided by the Takano system itself. Appellant fails to acknowledge the fact that Takano is a system and method for preparing patent specifications using a plurality of computers connected to a communication network, such as the Internet. Thus, the plurality of computers, i.e, multiple, independent entities, would necessitate Takano providing specific privileges for the different entities. Appellant further argues that Takano nowhere even suggest that any sort of permissions or access controls might be implemented. The Examiner respectfully disagrees and directs the appellant to the following disclosure of Takano.

Takano discloses in column 8, lines 7-24:

When the draft is to be revised, first the draft downloading means 201 of the computer 200 references the specification file management table 304 in the specification file 303 of the server computer 300; displays on a display unit (not shown) a list of all the pieces of invention report information registered in this table 304 (*or only those satisfying specific conditions [e.g. only those pertaining to inventors belonging to a specific department]*) (step A9); lets the patent-application-filing persons select a desired piece of invention report information; finds the storage address of the draft data pertaining to the selected piece of invention report information from the specification file management table 304; and reads the draft data from the specification file 303 on the basis of that address (step A10).

In column 10, lines 8-29, Takano discloses:

After the completion of entry procedure of processing by the draft entry
means 302 (step A14 in FIG. 2), the inventor checks the contents of the revised
draft data thereby entered, and if he or she is to make any required correction
(in this embodiment, for the sake of convenience, supplementation and/or
correction done by the inventor is referred to as "checking," and those by the
patent-application-filing persons, as "revision"), first the draft downloading
means 106 in the client computer 100 refers to the specification file
management table 304 in the specification file 303 of the server computer 300;
displays on the display unit (not shown) a list of all the pieces of invention
report information registered in this table 304 (*or only those satisfying
specific conditions [e.g. only those pertaining to the inventor concerned]*)
(step C1 in FIG. 9); lets the inventor select a desired piece of invention
report information; finds the storage address of the draft data pertaining to
the selected piece of invention report information from the specification file
management table 304; and reads the revised draft data from the specification
file 303 on the basis of that address (step C2). Here, the list displayed on
the display unit is similar to that illustrated in FIG. 5.

The Examiner is further confused by the appellant's statement that incorporating

the teachings of Serbinis would not provide any needed access-control protocols since

Takano does not have any need for such controls. The appellant states that the

Examiner's asserted benefits of Serbinis's teaching, collaborative file sharing and

workflow, document delivery and document distribution, are all features provided by

Takano. The appellant then states that Serbinis teaches away from the asserted

combination with Takano and cites as the reason that Takano depends on dedicated

client software, more specifically, the functionality present in those applications, such as

actuating text preparation software, actuating drawing preparation software,

synthesizing text and drawings, preparing draft data, adding a file and that because of

this, there is not suggestion that the dedicated client software might be provided by a

web browser. First the Examiner notes, that a thorough search of Takano failed to

disclose the terms *dedicated client* software.   Takano does disclose, col. 6, lines 44-

59):

> First, in the client computer 100, the draft preparation means 101
> actuates, at the instruction of the inventor, text preparation software, such
> as a known word processor (step A1 in FIG. 2), to let the inventor use the
> software to prepare text data for a specification for patent application,
> stating the contents of the invention he or she has accomplished, and actuates
> known drawing software (step A2) to let the inventor use the software to
> prepare drawing data to be appended to the specification for patent
> application. After that, the inventor prepares draft data for the
> specification for patent application, into which the text data and the drawing
> data are synthesized, by using said text preparation software to insert into
> (paste onto) the prepared text data the drawing data. The draft preparation
> means 101 adds a file name designated by the inventor to the draft data, and
> stores them into an external memory unit 104 (step A3).

Takano further discloses that the plurality of computers are connected to a

communication network, such as the Internet (col. 1, lines 8-17; col. 5, lines 45-51).

The appellant states Serbinis allows the electronic documents to be made

available for use on open systems, such as the Internet, allowing users to interact

through a web browser rather than requiring specialized client software. The software

disclosed in Takano is a means for preparing the text data, drawings , etc. The

interaction means of Takano is a plurality of computers connected to a communication

network, such as the Internet. Both Serbinis and Takano disclose document

preparation by the transmission and reception of data via a server computer (Takano

col. 2, lines 3-10; Serbinis col. 5, lines 4-15). The Examiner asserts that the

combination of Takano and Serbinis are analogous art since they are in the in the field

of appellant's endeavor and are reasonably pertinent to the particular problem with which the appellant is concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

As for appellant's argument that Serbinis teaches away from Takano, the Examiner respectfully disagrees. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be lead in a direction divergent from the path taken by the appellant." In re Gurley, 27 F. 3d 551, 553 (Fed. Cir. 1994). Nothing in Serbinis can be said to discourage a person having ordinary skill in the art from using the web browser and access controls taught in Serbinis in the claimed combination or to lead the skilled artisan in a direction divergent from the path taken in a direction divergent from the path taken by Takano.

Issue: There is no reasonable expectation of success in the combination of Takano and Serbinis.

First, the Examiner notes that the appellant has provided not evidence that there is no reasonable expectation of success in the combination of Takano and Serbinis.

MPEP 2143.02 states:

Reasonable Expectation of Success Is Required

OBVIOUSNESS REQUIRES ONLY A REASONABLE EXPECTATION OF SUCCESS

The prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)
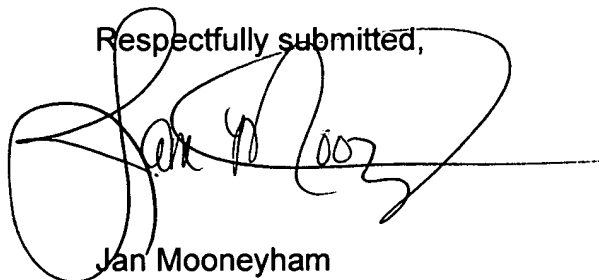
AT LEAST SOME DEGREE OF PREDICTABILITY IS REQUIRED;
APPELLANTS **MAY PRESENT EVIDENCE SHOWING THERE WAS NO
REASONABLE EXPECTATION OF SUCCESS**

Obviousness does not require absolute predictability, however, at least some
degree of predictability is required. Evidence showing there was no reasonable
expectation of success may support a conclusion of nonobviousness. In re
Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976).

The Examiner asserts that the appellant has provided no evidence showing there

is no reasonable expectation of success.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jan Mooneyham

Conferees:

John Weiss, Supervisory Patent Examiner 3629

Dean Nguyen, Primary Examiner 3629